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RE: PROPOSED RESPONSE FOR OC-527, SERIAL NO. 09/754,426

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PROPOSED RESPONSE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JAMES W. CASPER

Serial No.: 09/574,426

Filed: May 19, 2000

For: COATING COMPOSITION

Group Art Unit: 1762

Examiner: Bill Fletcher

Atty. Docket No.: OC-527

Box AF
Assistant Commissioner for Patents
Washington, DC 20231

Sir:

PROPOSED REMARKS

The Applicant would like to thank Examiner Fletcher for agreeing to conduct a telephone interview in this case. In order to facilitate the telephone interview, the Attorney for the Applicant has prepared this Proposed Response to highlight the issues and relevant facts.

In an Office Action mailed on December 12, 2002, Examiner Blanton stated that the response filed on December 2, 2002 failed to place the application in condition for allowance. Claims 1-15, 20, and 23-24 would remain rejected for the reasons set forth in the Office Action mailed on 10/30/02. The standing claim rejections and reasons for their traversal are discussed below.

I. Rejection of Claims 1-2, 5, 8-14, and 20

Claims 1-2, 5, 8-14, and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent Number 5,654,360 ("Palasz"). In order for a rejection to be proper under 35 U.S.C. § 102(b), a single source must contain all of the elements of the claim. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986).

In this case, the present invention is a paint pack. As defined in claim 1, the paint pack of the present invention comprises:

- i) a solution in an organic solvent of polymer having functional groups and hydrophilic groups; and
- ii) a waterborne pigment dispersion comprising pigment dispersed in water in the presence of a pigment dispersant, the aqueous pigment dispersion itself being in dispersion in said solution of organic solution.

According to the present invention, pigment is dispersed in water in the presence of a pigment dispersant and then the aqueous pigment dispersion is itself dispersed in a polymer having functional groups and hydrophilic groups.

Unlike the paint pack of the present invention, the coating composition disclosed in Palasz does not teach or suggest a paint pack having a waterborne pigment dispersion comprising **pigment dispersed in water** in the presence of a pigment dispersant, **the aqueous pigment dispersion itself being in dispersion in said solution of organic solution (which contains the polymer)**. The Palasz reference teaches preparing a pigmented coating composition by first dispersing pigment **using a suitable pigment dispersant polymer** (not water) by conventional techniques and then blending the

dispersed pigment or mill base with other constituents used in the coating composition. See Palasz at column 9, line 63. There is no mention of dispersing **an aqueous pigment dispersion** in an organic solution that contains a polymer(s).

Because every element of the present invention is not taught or disclosed by the Palasz reference, the rejection of claims 1-2, 5, 8-14, and 20 under 35 U.S.C. §102(b) over Palasz is improper and should be withdrawn.

II. Rejection of Claims 3-4

Claims 3-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Palasz in view of United States Patent Number 5,391,630 ("Miwa"). Claims 3-4 are dependent claims. For the reasons stated above, the independent claim should be allowed and hence claims 3-4 should also be allowed.

III. Rejection of Claims 6-7 and 15

Claims 6-7 and 15 stand rejected over Palasz under 35 U.S.C. § 103(a). Claims 6-7 and 15 are dependents. For the reasons stated above, the independent claim should be allowed and hence claims 6-7 and 15 should also be allowed.

CONCLUSION

For the reasons discussed above, the present application should be in condition for allowance. The rejections of claims 1-2, 5, 8-14, and 20 under 35 U.S.C. § 102(b) as being anticipated by United States Patent Number 5,654,360 ("Palasz"), claims 3-4 under 35 U.S.C. § 103(a) as being unpatentable over Palasz in view Miwa, and claims 6-7 and 15 over Palasz under 35 U.S.C. § 103(a) are improper and should be withdrawn. Thank you for your assistance in this matter.

Sincerely,
Jacques B. Miles